

REMARKS

The Office Action reopened prosecution of the present application in view of applicant's Appeal Brief and again rejected claims 1-35 under 35 U.S.C. §103(a) as allegedly being unpatentable over "New Tools Make It Easier to Find the Lowest Price" by Tedeschi ("Tedeschi") in view of U.S. Patent No. 6,598,026 to Ojha et al. ("Ojha"). Applicant respectfully traverses the rejection.

As understood by applicant, Tedeschi discloses e-commerce price comparison web sites. Tedeschi superficially explains that there are browser-based product search agents and price comparison web sites. The browser-based product search agents scan various shopping web sites and retrieve purchasing data for a particular product and display the purchasing data for the particular product to a shopper. The price comparison sites are independent web sites that compile retail store product data and provide a shopper with a list retail stores from which a particular product can be purchased. The shopper must then navigate to the particular retail store's web site. Unlike Applicant's invention, Tedeschi mentions nothing about e-commerce bidding or auctions, or the like, or a need for such a function to be incorporated into the existing e-commerce retail shopping or price comparison environment.

As understood by applicant, Ojha teaches a method and apparatus for brokering transactions. The method and apparatus facilitate a transaction between a buyer and one of a plurality of sellers via the Internet. Product information relating to a plurality of products meeting product criteria specified by the buyer is presented via the Internet. One of the plurality of sellers is associated with each of the products. A first bid from the buyer for a first one of the plurality of products is made available via the Internet to a first seller associated with the first product. A first bid response is presented via the Internet to the buyer according to response

criteria specified by the seller. The entire auction/bidding process is executed through a common transaction site (col. 9, lines 18-20). A buyer may only shop for (solicit bids for) products that are listed in a proprietary database (col. 9, line 37-41). If the desired product is not listed in the proprietary database, the buyer cannot use the system taught by Ojha to make a purchase. Ojha mentions nothing about price comparison web sites, or the like. Further, Ojha mentions nothing about a need for integrating the disclosed bidding/auction system with an e-commerce retail shopping or price comparison environment.

In contrast, applicant's invention recites an integrated e-commerce retail shopping and bidding method. Applicant's invention enables a shopper to shop at any online store for a particular product, while also soliciting bids for a better price of the particular product. While the shopper shops at any online store, a bidding agent residing on a server associated with the shopper's Internet Service Provider (ISP) tracks and retrieves product information related to the shoppers product of interest. The shopper has the option of purchasing the particular product at any online store of his choice, or soliciting bids for prices from a variety of additional retail stores.

Unlike the systems disclosed in Tedeschi, applicant's system does not necessarily limit the shopper to the prices for a particular product found on a particular retail web site or a price comparison website. Applicant's system provides the shopper with the opportunity to solicit bids from retailers that may be lower than prices listed on various web sites.

Unlike the method and apparatus disclosed in Ojha, applicant's method enables a shopper to shop any retail site or price comparison site that the shopper desires while also soliciting bids for lower prices. The shopper is thus not limited to using the bidding feature. Further, the

shopper is not limited to products listed in a proprietary database. The shopper can shop for products wherever he wishes.

Conceding that Tedeschi does not disclose dynamic price shopping, the Office Action nonetheless alleges that it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Tedeschi to add the well known dynamic price shopping mode, citing auction web sites such as eBay, uBid, and auction.com. The Office Action further appears to be alleging that the agent companies disclosed in Tedeschi could also scan the prices of the selected product from various dynamic price shopping sites, given Ojha description of its auction process.

To establish a prima facie case of obviousness, first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. The Office Action fails to establish a prima facie case of obviousness at least because neither Tedeschi nor Ojha provides the necessary suggestion or motivation. Furthermore, the knowledge generally available to one of ordinary skill in the art does not provide the missing suggestion or motivation. As discussed above Tedeschi nowhere even hints of providing dynamic shopping mode. That is, Tedeschi mentions nothing about e-commerce bidding or auctions, or the like, or a need for such a function to be incorporated into the existing e-commerce retail shopping or price comparison environment. Similarly, Ojha mentions nothing about a need for integrating its bidding/auction system with an e-commerce retail shopping or price comparison environment. Ojha is not concerned at all with e-commerce retail shopping or price comparison web sites, or the like.

Rather, Ojha is concerned with providing an electronic commerce solution by which individual buyers may negotiate online in a traditional and non-binding manner with one or more sellers (see Ojha, col. 2, lines 11-44). Thus, not only is there absence of the requisite teaching, suggestion, or motivation in Tedeschi and Ojha, but also, the nature of the problem to be solved as a whole in the two references are completely different.

In addition, it is not permissible to base obviousness upon what a person skilled in the art could, or might, try but rather must consider what the prior art would have led a person skilled in the art to do. In re Antonie, 559 F.2d 618 195 USPQ 6 (CCPA, 1977). Furthermore, “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination” (MPEP 2143.01 III, citing *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990)(emphasis in the original). To prevent the use of hindsight based on the invention to defeat patentability of the invention, the Examiner must show a motivation to combine the references that create the case of obviousness. In re Rouffet, 47 USPQ2d 1453 (Fed. Cir., July 15, 1998). The conclusion asserted in the Office Action represents an impermissible use of hindsight gained from the present invention at least because the Office Action has again failed to specifically identify a suggestion, motivation, or teaching why one of ordinary skill in the art would have been motivated to select the references and combine them.

In view of the foregoing, applicant believes that Tedeschi and Ojha, whether taken alone or in combination, do not teach or suggest the subject matter recited in claim 1 as each of these references fails at least to teach or suggest a computer-implemented method of doing business on a network. The method includes providing a user with access to a first online store through one or more networks and via an on-screen display, the first online store having one or more products, each with a product description and a price, the product description and price being

provided to the user via the on-screen display. The method further includes receiving one or more selection requests for the one or more products from the user via the on-screen display, wherein one of the products is a selected product. The method still further includes providing a fixed shopping mode, via the on-screen display, where the user conducts a product purchase transaction for said selected product via the first online store. The method yet further includes providing a dynamic price shopping mode, via the on-screen display, where the user initiates an auction in real-time for generating bids for the selected product from different online stores, other than the first online store, wherein the on-screen display allows the user to begin shopping in the fixed shopping mode, then initiate the auction in the dynamic shopping mode, then elect to return to shopping in the fixed shopping mode without being obligated to accept any of the bids provided in the dynamic shopping mode, but having a choice to select any of the bids provided in the dynamic shopping mode.

Independent claim 24 and 32 recite similar features as claim 1, and therefore are not obvious over Tedeschi and Ojha for at least the reasons discussed in connection with claim 1. Claims 2-23, 25-31, and 33-35, which depend directly or indirectly from the independent claims 1, 24, and 32 incorporate all of the limitations of the corresponding independent claim and therefore also are not obvious over Tedeschi and Ojha for at least those reasons provided for claims 1, 24, and 32.

In view of the foregoing, this application is now believed to be in condition for allowance, and a Notice of Allowance is respectfully requested.

If the Examiner believes a telephone conference might expedite prosecution of this case, it is respectfully requested that he call applicant's attorney at (516) 742-4343.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Steven Fischman', with a long horizontal flourish extending to the right.

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